

DETAILED ACTION

1. This action is responsive to communication filed 1/14/09.

Response to Amendment

2. Examiner acknowledges cancelled claims 2, 20, 25 and 31.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-19 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit¹, relying upon Supreme Court precedent², has indicated that a statutory "process" under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the "machine or transformation test", whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at

¹ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

² *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

590"). While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Regarding claim 1, the "determining and obtaining" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object. Claims 3-15 depend on claim 1. Therefore are also rejected

Regarding claim 16, the "generating and determining" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object. Claim 17-18 depend on claim 16. Therefore are also rejected.

Regarding claim 19, the "removing and generating" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an

external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object.

Allowable Subject Matter

4. Claims 21-24 and 26-30 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bella C. Matthew can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.D.

June 7, 2009

/Gregory M. Desire/
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